

REMARKS/ARGUMENTS

Request to Withdraw Final Office Action

The attention of the Examiner is directed to Applicant's Request To Withdraw Final Office Action for the present application, filed herewith. Applicant requested therein that the "Final" status of the office action mailed June 2, 2006, be withdrawn and the office action treated as a non-final office action, because U.S. patent no. 6,009,116 to Bednarek et al. constitutes a new ground of rejection to claim 9, which has not been substantively amended (i.e., it was rewritten independent form to include the subject matter of its base claim and any intervening claims).

In addition, the outstanding office action fails to provide a basis for rejecting claims 7, 9 and 87-91. As noted in the Applicants amendment filed on March 16, 2006, the first office action mailed on December 19, 2005, also failed to provide a basis for rejecting claims 7 and 9. As such, a subsequent office action that substantively addresses claims 7 and 9 should also be non-final to provide Applicants an opportunity to respond to such rejections when first presented.

The Office Action

The office action mailed June 2, 2006 (the Office Action) has been reviewed and these remarks are responsive thereto. Claims 1-105 are pending in this application. By this amendment, new claims 106-109 have been added. Support for the new claims can be found in the specification as originally filed.

Claims 7 and 9

Applicants note that claims 7, 9 and 87-91 were not addressed in the Office Action. As such, it would be improper to issue a final office action without permitting Applicants to address any rejections to these claims. Note also that claim 9 was previously rewritten in independent form, but was not substantively amended.

Applicants respectfully submit that claims 7, 9 and 87-91 are allowable over the prior art of record. Independent claim 1, the subject matter of which was previously added without substantive amendment to claim 9 and from which claims 7 and 87-91 ultimately depend, stands rejected as allegedly being unpatentable over U.S. patent publication no. 2005/0028208 to Ellis

et al. (Ellis) in view of U.S. patent no. 6,009,116 to Bednarek et al. (Bednarek). As noted on page 5 of the Office Action, “Ellis is silent to the use of Bluetooth interface for communication” and Bednarek fails to overcome this deficiency of Ellis. For at least this reason, claim 9 is allowable over Ellis.

In addition, the Office Action relies upon U.S. patent no. 6,824,048 to Itabashi et al. (Itabashi) for teachings of Bluetooth communications. However, Itabashi fails to teach or suggest the use of a Bluetooth link key generated from a passkey for authenticating the mobile remote control means as recited in claim 9. As noted in the specification at paragraph 0042 with respect to an example embodiment according to the invention, “when mobile phone 200 including the inhibiting device is purchased passkeys can be provided in the sales kit. The passkeys may be used for generating link keys and for establishing secured communication links between the both mobile phones 100 and 200.” For this additional reason, Applicants respectfully submit that the inventive subject matter of claim 9 is not taught or suggested by the prior art of record.

Further, as noted below, the inventive subject matter of independent claim 1, as amended, is allowable over the cited prior art. Accordingly, Applicants respectfully request consideration and allowance of claims 7, 9 and 87-91.

Claims 1-6, 8, 10-86 and 92-107

Claims 1-6, 8, 10-91 and 92-105 stand rejected as allegedly being unpatentable over Ellis in view of Bednarek or as allegedly being unpatentable over Ellis in view of Bednarek and further in view of Itabashi. New claims 106 and 108-109 depend from independent claim 1 and new claim 107 depends from independent claim 103.

Applicants respectfully submit that independent claim 1; claims 2-6, 8, 10-86, 92-102, 106 and 108-109 depending therefrom; independent claim 103; and claims 104, 105 and 107 depending therefrom are allowable over Ellis in view of Bednarek, either alone or in view of Itabashi.

Independent claim 1 recites, among other features, a method to inhibit functions of a first mobile terminal by using a second mobile terminal including “inhibiting certain functions of said second mobile terminal so that said functions are no longer operable by said controller, said

inhibiting being performed based on said transmitted inhibit rule data without being based on additionally provided data received by said second mobile terminal from one of a third device and a content source." Independent claim 103 recites similar subject matter pertaining to inhibiting certain functions. The subject matter of inhibiting functions on a mobile terminal, or doing so via rule data transmitted from a first mobile terminal without being based on additionally provided data received by said second mobile terminal from a third device or a content source, is not taught or suggested by Ellis, Itabashi or Bednarek.

Support for the amendments to claims 1 and 103 and for new claims 105 and 106 can be found in the application as originally filed. As noted on page 7 of the specification for an example embodiment, "to inhibit the functions of a device ... the necessary data are transmitted via a wireless interface." For optional configurations that take advantage of "an existing embodiment of ... identification and/or classification codes" (page 7 at lines 18 and 19), "inhibition can be determined using additionally provided data. These data comprise an identification and/or classification code" (*id.* at lines 10-12), such as rating information for video broadcasts and movies provided from digital versatile disks (DVDs). See also, specification, pages 12 and 13. However, for other configurations, such as configurations in which the inhibited device is a mobile phone or configurations in which telephone or game functionality is inhibited, functionality is inhibited based solely on the inhibiting data without being based on additional information from a third device or a content source. See Specification, pages 18-21.

In contrast to the claimed subject matter of independent claims 1 and 103, Ellis discloses an interactive television program guide that can be accessed via a remote control device and operates based on program guide data received from a program guide server. Abstract. Ellis teaches that a user may access and control features of the program guide, such as program guide parental control settings. However, Ellis clearly teaches that control of the program guide features is based on information transmitted from the remote program guide access device 24 AND on program guide information transmitted to the user's client device from a program guide server. Ellis, paragraphs 98 and 99. See also Ellis, paragraphs 100-103 and 107.

There is no teaching or suggestion in Ellis of inhibiting functions on a mobile terminal based on transmitted inhibit rule data without being based on additionally provided data received

by the second mobile terminal from one of a third device and a content source, as recited in independent claims 1 or 103.

Itabashi and Bednarek fail to overcome these deficiencies of Ellis and they were not relied upon to do so. Accordingly, Applicants respectfully submit that independent claims 1 and 103 as amended are allowable over Ellis in view Bednarek or Ellis in view of Itabashi and further in view of Bednarek. Applicants further submit that claims 2-6, 8, 10-91 and 92-107 are allowable along with independent claims 1 and 103 from which they respectively depend and further in view of novel features recited therein.

Claims 92-102

In addition to the reasons discussed above, Applicants respectfully submit that claims 92-105 are further allowable over the cited prior art in view of novel features recited therein. The Office Action fails to address the subject matter recited in these claims in addition to the subject matter of their respective base claims. As such, the Office Action fails to provide a *prima facie* basis for rejecting these claims.

The Office Action rejects claims 93-102 over Ellis in view of Bednarek by simply stating, "Claims 93-102 are met as previously discussed with respect to claims 1-4." However, these claims recite additional subject matter that clearly is not disclosed in the cited prior art. For example, claim 92 recites similar subject matter to claim 9 pertaining to a Bluetooth link key generated from a passkey, which should be allowable for similar reasons as claim 9 as discussed above. Further, claims 93, 94 and 96-102 recite subject matter pertaining to inhibiting functions of a mobile telephone or a mobile game device, which is not taught or suggested by the prior art of record or even discussed in the Office Action. For these additional reasons, Applicants respectfully submit that new claims 92-102 are allowable over the prior art of record.

Conclusion

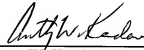
Based on the foregoing, Applicants respectfully submit that the application is in condition for allowance and a notice to that effect is earnestly solicited. Should the Examiner believe that anything further is desirable in order to place the application in even better form for allowance, the Examiner is respectfully urged to contact Applicants' undersigned representative at the below-listed number.

Respectfully submitted,

BANNER & WITCOFF, LTD.

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